

REMARKS

Applicants hereby responds to the Examiner's Action dated September 5, 2003.

Applicants respectfully request reconsideration of the prior art rejections of Claims 1-48 set forth by the Examiner under 35 U.S.C. §§ 102 and 103. Applicants respectfully submit that the prior art references of record whether considered alone, or in combination, fail to either teach or suggest Applicants' presently claimed invention. Applicants have herein addressed each of the Examiner's points of rejection.

67 In regard to the rejections under § 102, Applicants note that *Broadwin* (US Patent No. 5,929,850) is directed to an "interactive TV" system and method in which static images are broadcast to the client's TV, substantially in place of the main program through the use of a proprietary "still image broadcast channel." In sharp contrast, however, Applicants invention is directed to a system and method for displaying small advertisements overlaying the main program through the use of already available video bandwidth applicable to a standard broadcast television medium.

The Federal Circuit has held that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants invention is not anticipated by the *Broadwin* reference because it contains new and advantageous method steps and system structures not disclosed in the cited reference.

More specifically, Applicants invention provides a new avenue for advertisers by allowing the overlaying of promotional banners over a main program, which advantageously can remain onscreen when the user changes channels or web surfs, and which can be clicked

to bring up new images, video or other information. Alternatively, a banner can be used during a commercial break to countdown the time until the main program begins again, or to display other relevant information such as sports scores. Additionally the banner has the ability to be turned on or off by the client or by the broadcaster. The *Broadwin* reference provides no teaching or suggestion regarding these advances and only discloses a system whereby still images are displayed over the entire screen based upon the information sent over a separate, proprietary "still image broadcast channel."

The *Broadwin* specification clearly states that "when a user is navigating through still images, the television program or video content which was being viewed is displayed in a small window overlaid on the still image being displayed." (*Broadwin*, Col. 3, lns 6-9) The *Broadwin* invention is meant for obtaining static information pre-prepared to coincide with the main program being watched and subsequently displayed in place of the main program.

Applicants invention, on the other hand, provides for an advertising method in which a banner advertisement composed of a still or moving image is overlaid on top of the normal video channel. This allows a viewer to continue watching the regularly scheduled program at full-screen resolution while the advertiser can get placement of his or her promotional material overlaid on the main program in an infinite number of positions on the screen. In addition, the banner or window can be linked to other information retrievable over the device's internet connection. It may be linked to video retrieved through the broadcast or internet connections and stored on the device, or linked back to the same or different broadcast video channel. It should be apparent that Applicants invention contains significant advantages over *Broadwin*, and accordingly, a 35 U.S.C. § 102 rejection cannot be sustained.

We now address Examiner's specific rejection of claims 1,11,17,25,36,38,39, and 42 organized by Examiner's reason for rejection. The Examiner's second point of argument is that "*Broadwin* also discloses that the viewer has the option of enabling thumbnail still images to display additional information and thus discloses no longer displaying the television program by changing the subject matter displayed. *Broadwin* further discloses a window region continuing to display an indication of the television program segment." It is believed that Examiner's preceding statements are meant to support rejection of claims 1 and 11 of Applicants' claims.

However, Applicants' claims contain significant differences that distinguish it from *Broadwin*. Claims 1 and 11 are directed to a video window overlaying the main program screen that continues to provide its original information even after the user changes the channel or starts some other task. (See Applicants Specification, p. 2 lns 5-8) In one embodiment, this is a banner advertisement that corresponds to the commercial being run on the original channel. (See Applicants Specification, p. 5 lns 15-17) In another embodiment, it contains a counter that indicates to the user when the commercial break will be over. (See Applicants Specification, p. 7, lns 19-22)

This counter remains while the user continues to surf or view other channels, or surf the web. In another embodiment, this window contains sports scores relevant to the main program, that remain on the screen while the user changes channels or surfs the web. (See Applicants Specification, p. 8, lns 5-8) *Broadwin* does not teach or suggest any of these methods. Therefore, Claims 1, 11 and their respective dependent claims should be allowed.

Examiner's third argument is that "*Broadwin* further discloses circuitry (met by

antenna 120 and interactive decoder 140) for receiving an AV broadcast signal from a first source, i.e., a broadcast center 100 and circuitry for receiving still images from a second source, i.e., media server 180." It is believed that Examiner's preceding statements are meant to support rejections of claims 25, 36, 38, 39 and 42 of Applicant's claims. In regard to Claim 25, Applicants claim the means to provide information to be displayed in a banner window when the user elects not to view the main program. Applicant has modified claim 25 to underscore this difference.

For example, if a viewer decides to web browse or change channels during a program or commercial, the means provides information to be displayed in a banner window somewhere on the screen. The *Broadwin* patent only allows additional information to be brought up based on the current channel being watched, and significantly does not allow the user to change channels or web browse and still maintain the original loaded data on the screen. Therefore, it could not possibly anticipate or render obvious Applicant's invention.

Claims 36, 38-39, and 42 have been amended to more distinctly specify the differences in advantages of the current invention.

The Examiner's fourth argument is that "*Broadwin* further discloses the claimed video screen displaying a window indicating that the segment is being provided to the circuitry while the video screen displays the other visual information." It is believed that Examiner's preceding statements are meant to form rejections of claim 17 of Applicant's claims. That claim has been currently amended to make the distinguishing features clearer to the Examiner.

The claim describes the novelty of providing an indication of the current status of the video segment that the user was initially watching, after switching to another channel or

starting another task such as web browsing. This could be the time remaining in a commercial, the time remaining in the show, whether the signal is valid, or any other information of use to the user. Column 10, lines 48-55 of the *Broadwin* patent, as cited by the Examiner, only indicates that the video of the original segment may be displayed in a corner of the video screen while the user navigates video stills at full screen. This in no way relates to Applicant's claimed invention, and therefore, a rejection cannot be sustained. In light of the foregoing remarks and amendment, Applicants respectfully submit that claim 17 now also stands in condition for allowance.

Applicants need not address Examiner's rejection of claims 3,4,6,9,15,22,24,27,29,31, 37,40,41,43, and 44 as they each are dependent on base claims whose rejections have been traversed in the above section. In light of the foregoing remarks and amendments, Applicants respectfully submit that claims 1,3-6,9,11,14,15,17,18,22,24-27,29,31,36-44 all now stand in condition for allowance.

Applicants respectfully request reconsideration of the obviousness rejections set forth by the Examiner under 35 U.S.C. § 103 in light of the currently amended claims, and the following remarks. Each §103(a) rejection will be addressed individually below in the same sequence cited by the Examiner in the 9-5-03 Office Action.

In regard to Examiner's rejection of claims 2 and 8 based on *Broadwin* in view of *Sibecas* (US Patent No. 6,167,235), Applicants respectfully submit that their new invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As stated above, the *Broadwin* patent does not provide any teaching or suggestion to support the rejection to the base claims of Applicant's invention contained in Claims 2 and 8. In addition, *Sibecas* does not add any support to the teaching of *Broadwin* in relation to Examiner's §103

rejections.

Sibecas is directed to a method of delivering additional advertising information to a client's mobile device (pager, cell phone, etc.) based upon an advertisement broadcast on TV. In *Sibecas*, a static prompt is shown in the corner of a TV commercial, indicating that additional information is available over the mobile network. This prompt does not change from commercial to commercial, as the prompt is only an icon such as the FLEX trademark. (*Sibecas* Col. 3, lns 36-39) Therefore, when the commercial is over, the FLEX trademark will disappear if the next commercial does not support additional information over a mobile device, or it will stay up, unchanged, to indicate that additional information is also available via mobile device in the next commercial.

7 As for Claim 8, *Sibecas* in no way teaches changing the subject matter of the video screen window when the user changes channels on the TV. As stated above, *Sibecas* uses a static logo that is displayed during commercials that support receiving more information on your mobile device. When the channel is changed, at best, the new channel selected will just happen to be running a commercial also supporting the FLEX-based system and display the same static logo. The only thing that would be different after a channel change based on that system is the audio bursts contained in the audio signal during the commercial which would send different data to the mobile device. This in no way relates to Applicant's claimed invention, and therefore, a rejection cannot be sustained. In light of the foregoing remarks, Applicants respectfully submit that claims 2 and 8 now stand in condition for allowance.

In regard to Examiner's rejection of claims 7, 10, 16, 21, 23, 28, 45 and 46 based on *Broadwin* in view of *Kikinis* (US Patent No. 5,929,849), Applicants respectfully submit that their new invention is patentably distinct and contains sufficient novelty to overcome

Examiner's rejection. As stated above, the *Broadwin* patent does not provide any applicable teaching to support rejection of the base claims of Applicants invention contained in Claims 7, 10, 16, 21, 23, 28, 45 and 46. In addition, *Kikinis* does not add any support to Broadwin in relation to Examiner's §103 rejections. *Kikinis* is directed to a method of providing video in which certain regions of the video are tagged with a URL (uniform resource locator). A user can click on part of an image, which will cause the device to connect to the internet and access the Web Page of the URL associated with the part of the image the user clicked on.

Applicants need not address the patentability of claims 7, 10, 16, 21, 23, and 28 individually, as they are based on rejected base claims that are clearly allowable based on the above noted distinctions for base claims 1, 11, 17, and 25.

Claims 45 and 46 have been amended to further clarify the novelty of Applicant's invention. *Kikinis* prior art reference is directed to web surfing on a television, and while Applicant's claimed invention does allow for this capability, the function alone is not what is claimed. Applicant's invention allows for banners or images to be placed onscreen while the user is doing other tasks e.g. web surfing or channel surfing. The ability of the user to move these banners around is important as the user may not be given the ability to turn off the banner (via a flag set by the broadcaster).

For example, the user may choose to browse the web during a commercial. During this time, the broadcaster can place a banner onscreen based on the advertisement that is being shown on the previous video segment the user had on. Since the banner may cover text of a web page or e-mail a user may be accessing, it is important to be able to move it around. Examiner cites no further evidence of prior art or suggestion in the prior art to which an advertisement displayed in this manner and in this medium may be re-positioned by the user.

In light of the foregoing remarks, Applicants respectfully submit that claims 45 and 46 now stand in condition for allowance.

Applicants need not address the patentability of claims 12 and 13, as they are based on rejected base claim 11 that is now clearly allowable based on the above-noted distinctions.

7
In regard to Examiner's rejection of claim 19 based on *Broadwin* in view of *Hymel* (US Patent No. 6,157,814), Applicants respectfully submit that their new invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As stated above, the *Broadwin* patent does not provide any teaching or suggestion which supports the rejection of Applicant's invention contained specified claim 19. In addition, the *Hymel* reference does not add any support to *Broadwin* in relation to Examiner's §103 rejections. *Hymel* is directed to an advertising technique in which advertisements are sent to a user's cell phone along with a time duration that dictates how long the advertisement is to be displayed for on the phone. (*Hymel* Col. 4, lns 1-3) In contrast, Applicant's invention is significantly different than that disclosed in *Hymel*. The time duration sent in Applicant's invention is used to inform the user of the remaining time until the main program begins again. This is very different from that disclosed in *Hymel*, in which a timer is sent to dictate how long an advertisement is to be displayed on a cell phone. Additionally, In *Hymel*, the timer is not disclosed to the cell phone user. In light of the foregoing remarks, Applicants respectfully submit that claim 19 now stands in condition for allowance.

In regard to Examiner's rejection of claim 20 based on *Broadwin* in view of *Hymel* (US Patent No. 6,157,814), and *Sibecas* (US Patent No. 6,167,235), Applicants respectfully submit that the claimed invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As stated above, the *Broadwin* patent does not provide any

teaching or suggestion to support the rejection of Applicant's invention contained in claim 20. In addition, neither *Hymel* nor *Sibecas* add any support to *Broadwin* in relation to Examiner's §103 rejections.

Applicants also note that combining references of seemingly unrelated prior art in order to defeat patentability has not been allowed by the Federal Courts. The U.S. Court of Appeals for the Federal Circuit held in *Dembiczak* that "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *In re Dembiczak*, 50 USPQ2d, 1614, 1617. (1999) Both *Sibecas* and *Hymel* are related to advertising in a wireless device network such as cell phones, and neither of these two references relate to Applicant's invention. Neither *Sibecas* nor *Hymel* suggest combining technologies in order to anticipate Applicant's invention by applying their own technologies to the field of Applicant's invention. In light of the foregoing remarks, Applicants respectfully submit that claim 20 now also stands in condition for allowance.

In regard to Examiner's rejection of claims 30, 34, and 37 based on *Broadwin* in view of *Davis* (US Patent No. 6,138,155), Applicants respectfully submit that the claimed invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As stated above, the *Broadwin* patent does not provide any teaching nor suggestion to support the rejection of Applicant's invention contained in claims 30, 34, and 37. In addition, *Davis* does not add any support to *Broadwin* in relation to Examiner's §103 rejections of Applicants' claims. *Davis* is directed to a method of tracking a user's use of network-related resources. The process in *Davis* involves downloading a software application that executes on the client computer, and thereafter communicating with pre-

7 existing servers over the internet to send user tracking information back to the application provider. However, the internet was developed to be a two-way communicative network, while broadcasting has traditionally been a one-way communicative network. Therefore, implementing a tracking method of broadcast TV advertising is neither simple, nor obvious, in view of tracking advertising over the internet.

7 In support of this statement, Applicant takes notice that at no point in the *Davis* application does the inventor teach or suggest any applicability of the tracking technology disclosed therein to a one-way communicative network such as broadcast television. The Examiner's rejection is based on hindsight, and as such, does not support a rejection of obviousness. The US Court of Appeals for the Federal Circuit has held that "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *In re Dembiczak*, 50 USPQ2d, 1614, 1617. (Fed. Cir. 1999). In light of the foregoing remarks, Applicants respectfully submit that claims 30, 34, and 37 now stands in condition for allowance.

7 Applicants need not address the patentability of claims 32 or 33, as they are based on rejected base claim 30 that is now allowable based on the arguments above. In addition, with regard to claim 33, Applicants note that Examiner has taken "Official Notice," but fails to cite any evidence that such technology was known in the art at the time of the invention. It is well established that "The examiner must provide specific factual finding predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *In re Soli*, 37 USPQ 801 (1963); *In Re Chevenard*, 60 USPQ 241 (1943). Therefore, Examiner's rejection based on Official Notice cannot stand unless it is further supported by

sound references to the knowledge of one skilled in the art at the time of Applicant's invention. In light of the foregoing remarks, Applicants respectfully submit that claims 32 and 33 now stand in condition for allowance.

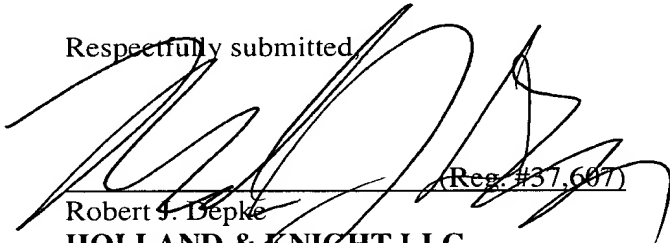
Applicants need not address the patentability of claim 35, as it is based on rejected base claim 34 that is clearly now allowable based on the arguments above.

Additionally, Applicants need not address the patentability of claim 48, as it is based on rejected base claim 34 that is now clearly allowable based on the arguments above

Applicants respectfully submit that the prior art references of record whether considered alone, or in combination, fail to either teach or suggest Applicants' presently claimed invention. In addition, Applicants submit that the prior art references of record cited but not relied upon also fail to either teach or suggest Applicants' presently claimed invention. Accordingly, Applicants' claimed invention is patentable and distinct over the art of record. In light of the foregoing, Applicants respectfully submit that all claims now stand in condition for allowance.

Respectfully submitted,

December 29, 2003


Robert J. Depke

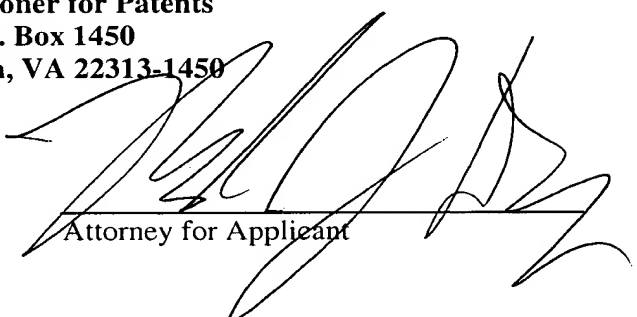
HOLLAND & KNIGHT LLC
131 South Dearborn, 30th Floor
Chicago, Illinois 60603
Tel: (312) 422-9050
Attorney for Applicant

(Reg. #37,687)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States
Postal Service as First Class Mail on December 29, 2003 in an envelope addressed to:

**Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**



Attorney for Applicant

1286226_v1